



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,029	10/29/1999	TETSUYA YANO	35.C13982	6685

5514 7590 03/15/2002

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

SLOBODYANSKY, ELIZABETH

ART UNIT PAPER NUMBER

1652

DATE MAILED: 03/15/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/430,029

Applicant(s)

YANO ET AL.

Examiner

Elizabeth Slobodyansky

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 18 December 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1 and 2.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 3-48,55.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*E. Slobodyansky*  
Elizabeth Slobodyansky  
Primary Examiner  
Art Unit: 1652

Art Unit: 1652

Attachment to the Advisory action (Paper #18)

The second AF amendment filed February 26, 2002 amending claims 9, 10 and 55 has not been entered because the scope of the claims has been changed requiring additional consideration and search.

The scope of the amended claims has been broadened by deletion of the functional language in connection to a protein encoded by an individual open reading frame. Therefore, there is no specific limitation on either the structure of a DNA that hybridizes under stringent conditions or function of the encoded protein. The claims would require the 112, 1st paragraph, rejections.

The claims would require 112, 2nd paragraph, rejection because depending on the conditions nucleotide sequences of different structures would hybridize with the given sequence. Without knowing the exact conditions there is no way of knowing nucleotide sequences of what structure (homology) are encompassed by the scope of the claims.

***Response to Arguments***

Applicants' Remarks filed February 26, 2002 have been considered.

The arguments presented on page 4, 3rd paragraph, of Remarks with regard to the 112, 1st, (written description) rejection of claims 6, 7 and 19 are persuasive.

Art Unit: 1652

Applicants arguments with regard to "stringent conditions" are not persuasive for the reasons discussed above. Applicants argue that "the phrase under stringent (hybridization) conditions is a well known and well understood expression to those of ordinary skill in the art. For example, this expression is present in the specification and/or claims of at least 59 patents issued in January 2001 as follows:" (Remarks, page 5, last paragraph). This is not persuasive because the rejection would be made not against "the phrase" but because the exact conditions are not defined. In fact, the first patent cited by Applicants, US 6,171,790, discloses that "stringent conditions can be defined by salt concentration, the concentration of organic solvent ..." column 11, line 26, through column 12, line 15. The inventors in US 6,171,790 discuss various and different conditions that are encompassed by the term "stringent conditions". Furthermore, the claims therein do not recite "stringent conditions" but recite percent homology that is related to specific stringent conditions and not to any stringent conditions.